

Attorney's Docket: 2002DE108
Serial No.: 10/511,857
Group: 1755

REMARKS

The Office Action mailed July 26, 2005, has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. The amendments made herein are fully supported by the application as originally filed. No new matter has been added. Accordingly, reconsideration of the present Application in view of the above amendments and following remarks is respectfully requested.

CLAIM STATUS

Claims 1-13 are pending in this Application. By this Amendment, Applicants have amended claims 1 and 10, claims 11-13 have been cancelled and new claim 14 has been added. Therefore, the claims under consideration are believed to include claims 1-10 and 14.

Claim Rejections Under 35 USC § 112, Second Paragraph

Claims 1-13 stand rejected under 35 USC § 112, second paragraph, as being indefinite.

With respect to claim 1, the Office states "it is unclear as to why applicant recites "reoxidizing" when a step of oxidizing does not appear to be present." Claim 1 has been amended to replace the word "reoxidizing" with the word "oxidizing".

The Office states that in claim 7, "applicant recites "oxidation" however no oxidation step appears in claim 1. Given the amendment to claim 1, it is respectfully contended that the word "oxidation" now has proper antecedent basis.

The Office states that claim 10 is indefinite for the use of the phrase "the leuco compound formed" as it appears to lack antecedent basis. In this Amendment, Applicants have removed the word "leuco" from claim 10.

The Office also rejects to claim 12, but as that claim has been cancelled, the rejection is now moot.

Attorney's Docket: 2002DE108
Serial No.: 10/511,857
Group: 1755

In view of the foregoing amendments and remarks, it is courteously contended that the 35 USC § 112, second paragraph, rejections have been overcome.

Claim Rejection Under 35 USC § 102 and 103

The Office sets forth a number of rejections for one or more of claims 11-13. Specifically, the Office sets forth those rejections in Paragraphs 5 - 12 and 14 - 16 of the Office Action. As claims 11-13 have been cancelled, such rejections are now moot.

In Paragraph 13 of the Office Action, the Office rejects claims 1-13 under 35 USC § 103(a) as being unpatentable over Hoch et al. (U.S. Patent No. 4,217,455 and 4,286,094) in view of Weber et al. (U.S. Patent Application Publication No. US 2001/0016656). This rejection is respectfully traversed.

Hoch ('455) discloses that shearing forces may be applied during oxidation of perylenetetracarboxylic acid bis-p-phenetide. It is stated in Hoch ('455) that the shearing forces are used to obtain transparent and easily dispersible pigments (column 4, lines 8-13). There are two examples in Hoch ('455) wherein shearing forces are applied during the oxidation step: Example 7, which yields pigment exhibiting the same properties as the pigment obtained in Example 5 (no shearing forces applied) and Example 8; providing a pigment with reduced gloss value. These examples show that applying shearing forces may or may not improve transparency but does not improve or change other coloristic properties. Hoch ('094) discloses the use of shearing forces during oxidation of leuco perylene tetracarboxylic acid diimide.

In contrast, the present invention describes a method of producing a vat-dyeable organic pigment wherein at least one of the oxidizing and vatting steps further comprising milling the aqueous organic suspension with a stirred ball mill operated under specific conditions. It has been recognized by Applicants that the combination

Attorney's Docket: 2002DE108
Serial No.: 10/511,857
Group: 1755

of ball milling and vatting and/or oxidizing under specific conditions yield a pigment having several superior color characteristics. As stated in the specification on page 11:

The pigments of the invention, when used for coloring high molecular mass organic materials, are distinguished by outstanding performance properties, in particular by outstanding rheology, ready dispersibility, high transparency, good gloss behavior, high color strength, excellent bleedfastnesses and overcoating fastnesses, and very good lightfastness and weatherfastness.

The Office puts forward the position that the Hoch patents in combination with Weber make the present invention obvious. Applicants respectfully can not agree. Courteously stated, there is nothing in either Hoch or Weber which would lead one with ordinary skill in the art to the conclusion that applying the techniques as advanced by Weber during the oxidation or vatting step produce a pigment having several enhanced color characteristics. As shown by the examples in the specification, the present invention provides pigments having a wide variety of superior color characteristics which heretofore have not been possible.

In order to sustain a *prima facie* case of obviousness, it is required that the prior art provide some motivation to one with ordinary skill in the art enabling the same to arrive at the instantly claimed invention. Here, such motivation is lacking. There is nothing either in Weber or Hoch which would explain to the ordinary artisan that a variety of coloristic properties could be significantly enhanced by concomitantly vatting and/or oxidizing and ball milling under the certain conditions recited in claim 1. As such references can not provide the requisite motivation, it is respectfully believed that the Office has constructed a position based on the improper use of hindsight gained by knowledge of Applicants' invention. Simply put, Applicants have arrived at an enhanced invention providing a number of increased color characteristics that could not be realized from a knowledge of the Hoch patents and Weber.

Attorney's Docket: 2002DE108
Serial No.: 10/511,857
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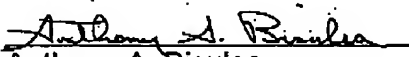
For at least this reason, Applicants are of the courteous position that the instantly claimed invention is not made obvious by any combination of Hoch patents and Weber. In consequence, Applicants respectfully request reconsideration and withdrawal of the rejection.

Information Disclosure Statement

The Office Action makes reference to a previously submitted IDS, stating it is not in compliance with 37 CFR § 1.98 and 37 CFR § 1.98(a)(2). A discussion was had between the Examiner and the undersigned on December 14, 2005 wherein it was determined that the IDS, the 1449 and the references were not in the Office's file when the Examiner created the Office Action, although such IDS was timely filed. Upon scrutiny of the Office's file, the Examiner determined that the IDS, complete with all the references necessary to comply with § 1.98, were in the record and were timely filed. It is, therefore, believed that the IDS of May 25, 2005 is in condition for review and complies with all necessary statutory requirements. Applicants thank Examiner Green for his courteous review of this situation with the undersigned.

In view of the forgoing amendments and remarks, the present application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, he is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,


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